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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,623	01/17/2001	Sadami Okada	37026-88077	5313

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EXAMINER	
THOMPSON, JAMES A	

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/761,623	Applicant(s) OKADA ET AL.	
	Examiner James A. Thompson	Art Unit 2625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): rejection of claims 12-15 and 17-22 under 35 USC §112, 2nd para.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-4,6-15 and 17-33*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Since Applicant's proposed amendments merely overcome a rejection under 35 USC §112, 2nd paragraph and do not therefore require any prolonged reconsideration of the claims, **the proposed amendments to the claims are entered.** The prior art rejections set forth in the previous office action, dated 25 February 2006 and mailed 03 March 2006, are maintained as is.

Response to Arguments

2. Applicant's arguments, see page 13, lines 20-27, filed 02 June 2006, with respect to the rejections of claims 12-15 and 17-22 under 35 USC §112, 2nd paragraph have been fully considered and are persuasive. The rejections of claims 12-15 and 17-22 under 35 USC §112, 2nd paragraph listed in items 2-3 of said previous office action have been withdrawn.

3. Applicant's arguments filed 02 June 2006 have been fully considered but they are not persuasive.

Regarding page 13, line 29 to page 16, line 7: Examiner appreciates Applicant's explanation of the present invention. While Examiner does note that the structure of the invention set forth in the present specification and drawings demonstrates a structural difference between the disclosed invention and the apparatus set forth in Katayama (US Patent 5,537,496), this distinction is not explicitly recited in or implicitly required by the present claims. Claim 1, for example, simply recites *inter alia* a first converting unit, a second converting unit, and a dissimilarity calculating unit. The recited dissimilarity

calculating unit calculates dissimilarity between the primary data and the secondary data according to each position of each pixel and employs the calculated data as tertiary data. There is no recitation that requires a direct and separate connection from each of the first and second converting units to the dissimilarity unit, as depicted in the figure provided in the attachment to Applicant's present arguments. Furthermore, there is no requirement in the recited claims that the second converting unit directly obtain the data to be operated upon from the image source. Applicant is respectfully reminded that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The dissimilarity calculating unit is taught in Katayama as embodied within the random number generator. It is not the random number generation itself that teaches the dissimilarity calculation. Rather, it is the calculations performed in the random number generator that are used to set up the random number generation that teaches the dissimilarity calculations. Examiner cited figure 5 and column 6, lines 3-19 of Katayama in support of this position. The cited figure and the passage clearly shows that the dissimilarity (decimal portion) between the primary (N-bit) data and the secondary (M-bit) data is calculated (figure 5 and column 6, lines 8-14 of Katayama) and used as tertiary data for the purpose of setting up a K-bit random number generation (column 6, lines 10-19 of Katayama).

Regarding page 16, line 9 to page 17, line 2: There is nothing unworkable about the proposed combination of Katayama and Ball (*Sams Teach Yourself Linux in 24 Hours*, by Bill Ball and Stephen Smoogen, copyright 1998, Sams Publishing and Red Hat

Press). Ball is simply a reference that discusses various well-known aspects of computer technology and operating systems. Katayama does not go into explicit detail with respect to how the computing system is structured, since such detail is tangential to the main focus of the system of Katayama. Katayama clearly shows that ordinary computer workstations, equipment and networks are used with respect to the system taught by Katayama, such as shown in figure 2 of Katayama. Ball discusses well-known details of computer systems.

One teaching provided for in Ball is a recording unit for storing digital data in a computer file (page 78, lines 5-7 of Ball). Actually, such a teaching would be implicit in Katayama since Katayama teaches the use of computers, workstations, etc., but Ball sets forth the recording unit explicitly. Furthermore, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Katayama and Ball are analogous art since they are from similar problem solving areas, namely the storage and manipulation of computer data.

Regarding page 17, lines 4-8: The combination made with respect to Imai (US Patent 6,038,369) and the combination made with respect to Hayashi (US Patent 5,754,683) are clearly set forth in said previous office action. Since it has been demonstrated that the Katayama-Ball combination is proper, the further combinations with respect to Imai and Hayashi cannot be considered improper for the same or similar reasons.

Regarding page 17, lines 10-12: Since claim 1 has been demonstrated to be obvious over Katayama in view of Ball, claims 2-4 and 6-11 cannot be considered allowable merely owing to their ultimate dependency from claim 1.

Regarding page 17, line 14 to page 20, line 5: Applicant restates the arguments that were addressed above, now with respect to claims 12, 23-27 and 29-33. Claims 12, 23-27 and 29-33 are therefore considered to not be allowable owing to the same reasons.

Regarding page 20, lines 7-15: Firstly, while the invention disclosed in the specification may provide additional benefits over Katayama, this does not demonstrate that the recited claims distinguish over the prior art. Secondly, the alleged benefits do not relate to the Katayama-Ball combination set forth in said previous office action since Ball is relied upon merely for the teaching with respect to a recording unit for storing digital data in a computer file. So, this form of secondary consideration is not particularly relevant to the combination that has been set forth in said previous office action.

Regarding page 20, line 17 to page 21, line 7: Improper hindsight reasoning has not been employed in the Katayama-Ball combination. A recording unit for storing digital data in a computer file is common computer equipment, and one of ordinary skill in the art at the time of the invention would have readily understood the motivation to use said recording unit disclosed in Ball. Furthermore, Katayama and Ball have both been shown to be analogous art [page 4, lines 21-26 of said previous office action], the relevant teaching is found within Ball [page 4, lines 19-20 of said previous office action], and the combination

and motivation to combine (found explicitly in Ball) have clearly been set forth [page 4, line 26 to page 5, line 3 of said previous office action]. Applicant is respectfully reminded that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion: All prior art rejections under 35 USC §103(a) in said previous office action are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Thompson
Examiner
Technology Division 2625

09 June 2006

THOMAS D. LEE
PRIMARY EXAMINER